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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/692,601	10/19/2000	Yoshio Miyazaki	285230US6	7919
22850 7590 04/03/2007 OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER CHU, KIM KWOK	
			ART UNIT 2627	PAPER NUMBER

SHORTENED STATUTORY PERIOD OF RESPONSE	NOTIFICATION DATE	DELIVERY MODE
3 MONTHS	04/03/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Notice of this Office communication was sent electronically on the above-indicated "Notification Date" and has a shortened statutory period for reply of 3 MONTHS from 04/03/2007.

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patentdocket@oblon.com
oblonpat@oblon.com
jgardner@oblon.com

Office Action Summary

Application No.

09/692,601

Applicant(s)

MIYAZAKI, YOSHIO

Examiner

Kim-Kwok CHU

Art Unit

2627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on RCE on 3/2/2007 and Amendment on 2/13/2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 October 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Request for Continued Examination

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on **March 2, 2007** has been entered.

Response to Remarks

2. Applicant's Remarks and Amendment filed on February 13, 2007 has been fully considered. Applicant states that the prior art of Tsukatani does not teach "for any element that determined if the content of data is the same as previously stored content (page 8 of the Remarks, lines 6 and 7). Accordingly, Applicant does not claim such limitation. For example, in the amended Claim 9, lines 6 and 7, Applicant's control circuit is used to "search an information data related to the digital audio in said internal memory". In other words, Applicant's internal memory stores the related information data to the digital audio, there is no claiming of the audio's content is being searched. As a result, Applicant's claimed control circuit does not search the content (song) of the digital audio, the control circuit search

the related information data instead.

The related information data of a digital audio has a broad meaning and it can be considered as the header files or TOC data of the claimed digital audio.

Applicant states that the interview of December 18, 2006 has an agreement that the proposed amendment of Claims 9 overcomes the prior art of Tsukatani et al. (page 1 of the Remarks, lines 10-14). Accordingly, the interview is about the proposed feature "digital audio" and it has nothing to do with the added feature "to search an information data related to the digital audio data in said internal memory" as presented in the amended Claim 1.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

*A person shall be entitled to a patent unless--
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.*

4. Claims 9-18 are rejected under 35 U.S.C. § 102(b) as being anticipated by Tsukatani et al. (U.S. Patent 5,778,257).

5. Tsukatani teaches a recording apparatus having all of the elements and means recited in claims 9-13. For example, Tsukatani teaches the following:

(a) with respect to Claim 9, a reproduction unit 35 configured to reproduce digital audio data from a standard compact disc 10 (Figs. 1 and 7; steps S101/S105; column 4, lines 53-55); a recording unit 35 configured to write the digital audio data from the standard compact disc 10 to the internal memory 32, 37 (Fig. 1; column 4, lines 44 and 45; column 5, lines 30-35); and a control circuit 30 configured to search an information data (PMA and TOC files) related to the digital audio data in the internal memory 32, 37 (Figs. 2 and 4; column 5, lines 25-35), if the control circuit 30 determines that the information data (PMA and TOC files) of the digital audio data has been stored in the internal memory 32, 37 (Figs. 7), the control circuit 30

prohibits writing the digital audio data into the internal memory 32, 37 (Fig. 7; step S102, step S103 is not needed), and if the control circuit 30 determines that the information data (PMA and TOC files) are not stored in the internal memory 32, 37 (new disc with new audio data is loaded), the control circuit 30 writes the digital audio data from the standard compact disc 10 to the internal memory 32, 37 (Fig. 7; buffer memory 37 contains audio files during audio loading operation).

(b) with respect to Claim 10, the internal memory 32, 37 additionally contains at least one control table (data array) configured to store the information data (Fig. 1; PMA and TOC are stored in the memory) and the control circuit 30 is configured to search (read/access) the internal memory 32, 37 to determine when digital audio data from the standard compact disc 10 is present on the internal memory by searching the control table (Fig. 1; information about PMA, TOC, type of disc etc. are copied when the disc is newly loaded in the apparatus).

(c) with respect to Claim 11, the internal memory 32, 37 is a hard disk drive (Fig. 1; a hard drive is used as a buffer memory for large quantity of data stored in the disc).

(d) with respect to Claim 12, a display means 1 connected to the control circuit 30, wherein when the control circuit 30 has determined that the digital data from the standard compact disc 10 is not present (not copied) on the internal

memory 32, 37, the display means displays information (user interface) indicating that the compact disc 10 has already been recorded (Fig. 1; buffer memory stored and display the status of the disc 10).

(e) with respect to Claim 13, a data compression and encoder circuit 33, 35 configured to compress (one of the encoding/decoding method) the digital audio data from the compact disc 10 so that when the digital audio data is written from the standard compact disc 10 to the internal memory 32, 37, the digital audio data may be compressed to occupy less space on the internal memory (Fig. 1; compressed data such as MP3 has a smaller file size than a typical audio file stored in a CD).

6. Method claims 14-18 are drawn to the method of using the corresponding apparatus claimed in claims 9-13. Therefore method claims 14-18 correspond to apparatus claims 9-13 and are rejected for the same reasons of anticipation as used above.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 19-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsukatani et al. (U.S. Patent 5,778,257) in view of Brewer et al. (U.S. Patent 6,661,430).

Tsukatani teaches an information recording/reproducing method very similar to that of the present invention. For example, Tsukatani teaches the following steps:

(a) searching information data (PMA and TOC files) related to the digital audio data in an internal memory 32, 37 (Figs. 2 and 4; column 5, lines 25-35), determining if the information data (PMA and TOC) of the digital audio data is already stored in the internal memory 32, 37 (Fig. 7); prohibiting writing said digital audio data into the internal memory 32, 37 if the determining step determines that the information data (PMA and TOC files) is already stored in the internal memory 32, 37 (Fig. 7; step S102, step S103 is not needed); and writing the digital

audio data from the standard compact disc 10 to the internal memory 32, 37 if the determining step determines that the information data is not already stored in the internal memory 32, 37 (Fig. 7; buffer memory 37 stores audio files during audio loading operation).

However, Tsukatani does not teach that above steps are executed by a computer program instructions.

Brewer teaches a computer program having executable instructions for audio files searching and copying operations.

Files searching and copying processes in Tsukatani's disc apparatus are automatic operations controlled by the central processing means 30. Hence, to control the searching and copying of a certain type of files, it would have been obvious to one of ordinary skill in the art to program Tsukatani's file searching and copying flow processes in executable instruction steps such as Brewer's because the program steps can be modified and updated according to various user requirements and then executed by the CPU.

(b) with respect to Claim 20, Tsukatani in view of Brewer further teaches that the searching includes searching at least one control table (data array) stored in the internal memory 32, 37 (Fig. 1), the control table storing information data (Fig. 1; PMA and TOC are stored in the memory).

(c) with respect to Claim 21, Tsukatani in view of Brewer further teaches that the searching includes searching information data related to the digital audio data in a hard disk drive (Fig. 1; a hard drive is used as a buffer memory for large quantity of data stored in the disc)..

(d) with respect to Claim 22, Tsukatani in view of Brewer further teaches that displaying information on a display 1 indicating that the compact disc 10 has already been recorded if the determining determines that the information data is already stored in the internal memory (Fig. 1; buffer memory stored and display the status of the disc 10).

(e) with respect to Claim 23, Tsukatani in view of Brewer further teaches that compressing the digital audio data from the compact disc so that when the digital audio data is written from the standard compact disc to the internal memory, the digital audio data occupies less space on the internal memory (Fig. 1; compressed data such as MP3 has a smaller file size than a typical audio file stored in a CD).

9. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Kim CHU whose telephone number is (571) 272-7585 between 9:30 am to 6:00 pm, Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrea Wellington, can be reached on (571) 272-4483.

The fax number for the organization where this application or proceeding is assigned is (571) 273-8300

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished application is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9191 (toll free).

Kim-Kwok CHU

100 3/28/07
Examiner AU2627

March 28, 2007

(571) 272-7585


ANDREA WELLINGTON
SUPERVISORY PATENT EXAMINER